

REMARKS

The claims in the application are Claim 1 and Claims 28-49 added by the present Amendment.

Favorable reconsideration of the application as amended is respectfully requested.

Independent Claim 1 has been amended to recite the stretched film possesses gloss from 15 to 60% and opaqueness from 83 to 96%; support for these ranges can be explicitly found in the Examples and accompanying tables in the present application. Independent Claim 28 corresponds to independent Claim 1 but with recitation on gloss and opaqueness omitted, while independent Claim 29 introduced herein additionally omits recitation on generation of the ultrafine cracks upon stretching. Claims 30-49 introduced herein respectively correspond to previously-pending Claims 2-20 and 27.

Accordingly, the set of claims introduced herein finds clear, unequivocal support throughout the present application. In this regard, the rejection of Claims 1-20 and 27 under 35 U.S.C. §112, first paragraph, in paragraphs 1 and 2 on page 2 of the Office Action has been explicitly eliminated. Accordingly, the only outstanding issue is the art rejection of the claims.

More particularly, all claims had again been rejected under 35 U.S.C. §103 as obvious over U.S. Pat. No. 4,318,950 to Takashi et al in view of European Patent No. 0613919 to Ueda et al and U.S. Pat. No. 5,233,924 to Ohba et al in paragraph 1 on pages 3-6 of the Office Action. Takashi et al are being relied upon as the primary

reference teaching a biaxially oriented polyolefin useful as a synthetic paper, with Ueda et al being relied upon as teaching the claimed antistatic agent (albeit in a molded composition, not a paper). Hence, the Examiner asserts it obvious to incorporate the antistatic of Ueda et al in the paper of Takashi et al. Ohba et al are not commented upon in the instant Office Action.

These references have been extensively addressed in prior responses, with several Declarations from the inventor, Masaaki Yamanaka, having been submitted in support of patentability and documenting the advantages provided by the claimed synthetic paper herein. In this regard, these Declarations will be summarized to show that surprising, unobvious advantages of the claimed invention have indeed been documented. Accordingly, the following points (i)-(ix) are enumerated:

(i) In the first Office Action mailed November 2, 1998, it was asserted by the Examiner in paragraph 1 it is obvious to use the polyolefin of Ueda et al in the paper of Takashi et al. This rejection was repeated in the final Office Action mailed May 20, 1999 where it was explicitly stated, in paragraph 9, Takashi et al is relied upon as teaching processing of an antistatic composition into synthetic paper, with Ueda et al relied upon to show a polypropylene composition having improved antistatic properties;

(ii) In the first Declaration executed by inventor Masaaki Yamanaka on Oct. 6, 1999 (Yamanaka I Declaration), a comparison of the inventive paper to one prepared according to Takashi et al showed clear improvement in antistatic properties possessed by the inventive paper over Takashi et al. However, this comparison was

dismissed in the first Office Action mailed December 27, 1999 on the grounds, among other reasons, it would be obvious to increase levels of antistatic agent taught in Takashi et al to improve antistatic properties;

(iii) In the final Office Action mailed May 25, 2000 in the present application, the Examiner now relied upon Ueda et al as allegedly teaching the claimed antistatic composition utilized in the inventive paper and further, in paragraph 3 thereof, there were too many variables in the comparative testing of the Yamanaka I Declaration, with the proper comparison being to a synthetic paper of Takashi et al having a different antistatic agent from the claimed polyetheresteramide (the top of page 7 of this action). In light of this rejection, a Supplemental Declaration executed by inventor Masaaki Yamanaka on March 22, 2001 (Yamanaka II Declaration), documenting the comparative testing in Yamanaka I was carried out under identical conditions for all paper, was submitted. However, in the Office Action mailed April 30, 2001 in the present application, the Examiner maintained, in paragraph 3, the comparisons remain invalid because more than one variable is changed;

(iv) In a Second Supplemental Declaration executed July 12, 2002 by Masaaki Yamanaka in the present application (Yamanaka III Declaration), a comparison was conducted between Example 12 of Takashi et al and with both polyetheresteramide and other antistatic agent, against the inventive paper. The results in the Yamanaka III Declaration clearly document both improved antistatic properties and printability. However, the Yamanaka III Declaration has been attacked in the Office Action mailed January 27, 2003 on the grounds, among other reasons

[S]aid experiment does not agree in scope with the present claims [emphasis added] (Page 4, bottom)

However, it is respectfully pointed out this experiment recreates the composition of Takashi et al, and not the claimed paper; the test results presented in the Yamanaka III Declaration specifically prepare and ultimately compare paper according to the combination of Takashi et al with Ueda et al, as the Examiner has explicitly requested. More particularly, the Yamanaka III Declaration explicitly compares compositions prepared with

(a) the composition of Example 12 of Takashi et al with the antistatic agent and amount taught in Takashi et al (Experiment 1);

(b) an identical composition according to Takashi et al, except for substitution of a polyetheresteramide antistatic agent according to the present invention (Experiment 2); and

(c) an identical composition to (b) supra, except using the polyetheresteramide in a much larger amount of 20 parts by weight (Experiment 3), with a composition prepared according to the present invention (Experiment 4). As clearly documented, surface resistivity improved after washing with only the inventive composition (Experiment 4), with satisfactory printability only being attained with the inventive composition. Further, it was attempted to prepare a film comprising a

composition taught in Ueda et al according the processing conditions of Takashi et al, in the Yamanaka III Declaration (Experiment 5). It has been documented impossible to prepare such a film in the Yamanaka III Declaration;

(v) However, in the Office Action mailed January 27, 2003, the Examiner dismisses the Yamanaka III Declaration by first stating Takashi et al is relied on as teaching a biaxially-oriented polyolefin composition useful as paper with Ueda teaching the antistatic component (Ueda et al not being relied upon for teaching their entire composition), and then stating Ueda et al are not limited to molded compositions, i.e., their teachings. This is a total contradiction;

(vi) In a third Supplemental Declaration executed by inventor Masaaki Yamanaka on May 19, 2003 (Yamanaka IV Declaration), eight experiments were carried out preparing different-layer films under a variety of conditions utilizing the composition prepared according to Example 12 of Takashi et al (Experiments 1-4), different-layer films prepared according to Example 1 in the present application (Experiments 5-7), and a three-layer film prepared according to Takashi et al but with a polyetheresteramide antistatic agent in large amount (Experiment 8). The results documented in the Yamanaka IV Declaration clearly indicate

(a) good resistivity and offset printability was only attained by paper prepared according to the claimed invention (Experiment 7), and

(b) a paper prepared according to Takashi et al and containing an antistatic agent of the type and amount of Ueda et al still failed to result in good resistivity and printability (Experiment 8);

(vii) In the Office Action mailed July 11, 2003, it is stated by the Examiner in the paragraph bridging pages 3-4:

The examiner points out that the rejection does not suggested [sic] that the entire composition of Ueda should be utilized. Rather, the rejection states that it would have been obvious to utilize the anti-static agent taught in Ueda in the composition taught in Takashi [emphasis added].

However, the Examiner is merely picking and choosing selected portions of each reference with no regard to even the slightest suggestion of combining these two references. The only suggestion to prepare the inventive paper is found in the present application itself, which cannot be used to fashion a prior art rejection in hindsight;

(viii) In attacking the Yamanaka IV Declaration on page 5 of the July 11, 2003 Office Action, the Examiner states

[T]he second experiment is not representative of a paper rendered obvious by Takashi in view of Ueda. . . . Ueda teaches that b2 is necessarily present and components C, and D are desirably present. . . .

However, this is directly contrary to other assertions by the Examiner in this and previous Office Actions that Ueda et al are only relied upon for teaching the antistatic agent and not any other components. Then, when a composition according to Ueda et

al was unsuccessfully prepared into a film in the Yamanaka III and IV Declarations, the Examiner simply dismisses this test result as "not representative of the prior art" [emphasis added] on page 6 of the July 11 Office Action; and

(ix) On page 6 of the July 11, 2003 Office Action, the Examiner disagrees high molecular weight antistatic agent of Ueda et al. has been tested in the comparative compositions of the Yamanaka III and IV Declarations. Attention is again respectfully called to Production Example 1 on page 26 of the present application, where it is explicitly stated an ethylene oxide adduct of bisphenol A having a number average molecular weight of 1,000 is incorporated into the polyetheresteramide of the inventive paper. Incorporation of this component b2 is described in greater detail at page 10-12 of the present application. Polyetheresteramide B1 contains component b2; polyetheresteramide B2, prepared according to Production Example 2 on page 27 of the present application, also contains component b2. Accordingly, component b2 is clearly present in the antistatic agent component of the inventive paper.

Accordingly, in view of the forgoing amendment and accompanying remarks, it is respectfully submitted the present application is in condition for allowance. Should the Examiner have any questions, then it is respectfully requested the undersigned attorney be contacted at the earliest convenience to discuss the present application. A petition

for an automatic one month extension of time for response under 37 C.F.R. §1.136(a) is enclosed in triplicate together with the requisite petition fee and fee for additional claims introduced herein.

Early favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "George M. Kaplan", is written over a horizontal line.

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